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09/928,451	08/14/2001	Akihiko Okada	Q65793	8140

EXAMINER	
BROOKS, MATTHEW L	

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/928,451	<b>Applicant(s)</b> OKADA, AKIHIKO	
	<b>Examiner</b> Matthew L. Brooks	<b>Art Unit</b> 3629	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 August 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 and 14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

**DETAILED ACTION*****Drawings***

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the system components of the claims (ie; a drawing showing the system of a service status detecting unit, a customer product information storage device, a sales promo terminal and a manufacturing point terminal) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

2. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

*The Abstract is longer than 150 words and no longer accurately and concisely reflects the claimed invention.*

3. 35 U.S.C. 112, first paragraph, requires the specification to be written in "full, clear, concise, and exact terms." The specification is replete with terms which are not clear, concise and exact. The specification should be revised carefully in order to comply with 35 U.S.C. 112, first paragraph. Examples of some unclear, inexact or verbose terms used in the specification are: found on page 19, lines 3-17 "...to thereby and confirm..." The whole specification is replete with errors and appears to be a machine translation from one language to English and has resulted in much confusion. Appropriate action is required fixing all of the omnibus language along with an oath that while correcting spec no new matter is or has been added.

***Claim Objections***

4. Claims 1-12 and 14 are objected to because of the following informalities: the newly amended language is a wherein clause and does not functionally change the system. Also because it "mediates the supply" it appears as if Applicant has now incorporated a method step into the system. Rather this is only an intended use of the system. Appropriate correction is required.

***Claim Rejections - 35 USC § 112 1<sup>st</sup>***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1-12 and 14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no teaching in the spec of the manufacturing terminal managing supply info of the terminal nor is there any teaching of the sales promoting terminal mediating supply info and/or demand info.

7. Claims 1-12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The spec does not teach how the terminal

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"mediates the supply" and because there is an infinite amount of ways to do this there is an undue burden on the examiner to determine how this is to be accomplished rather than just saying it.

***Claim Rejections - 35 USC § 112 2<sup>nd</sup>***

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 1-12 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

10. Claims 1 for example recites the limitation "and demand information obtained" in the last three lines. There is insufficient antecedent basis for this limitation in the claim. As of yet there has been no demand information obtained

11. The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

12. Claims 1-12 and 14 rejected under 35 U.S.C. 112, second paragraph, as being indefinite in that it fails to point out what is included or excluded by the claim language. This claim is an omnibus type claim.

13. The term "mediates the supply" in claims is a relative term which renders the claims indefinite. The term is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

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***Claim Rejections - 35 USC § 102***

14. The following is a quotation of the appropriate paragraphs of 35

U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

15. **Claims 1-8 and 14** are rejected under 35 U.S.C. 102(b) as being

anticipated by PN: 6,009,078 (Kodimer).

16. With respect to **Claims 1, 2 and 14**: Kodimer discloses

A computer peripheral sales promoting system comprising:

(a) a service status detecting unit that detects a service status of a computer peripheral (C1, 63-68);

(b) a customer product information storage device that stores specification information of said computer peripheral and user information which specifies a user of said computer peripheral and also consecutively updates and stores a service status detected by said service status detecting unit, wherein said service status detecting unit and customer product information storage device are provided in a computer which serves as an upper-level system for said computer peripheral (C2, 1-6 and C3, 14-20 → in regards to the option of having an “upper level” computer; and C4, 40-46 and C5, 45-52 and C6 30-42 and C12, 4-10) ;

(c) a sales promoting terminal for providing access to said customer product information storage device to thereby read out said specification

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information, said user information, and service status (C1, 45-53 and C12, 4-10 and C12, 55-65): and

(d) a manufacturing point terminal which manages supply information of the computer peripheral (C1, notify manufactures technical support, must be at some type of terminal which system manages all information including that of supply,

wherein said sales promoting terminal mediates the supply information sent by the manufacturing point terminal and demand information obtained from the customer product information storage device (C1, 40-50 Kodimer teaches both use of mfg and sales organization and service dept. interchangeably, furthermore this new language creates huge indefiniteness problems, see 112 above).

17. With respect to **claims 3 and 4**: Kodimer discloses

wherein said computer peripheral is arranged in a network (see Fig 1 and C1, 40-45 "network peripheral device).

18. With respect to **claims 5-8**: Kodimer discloses

wherein said computer peripheral comprises a data storing apparatus (See Fig 1, 11 wherein a printer comprises a data storing apparatus in that it has a memory.

### ***Claim Rejections - 35 USC § 103***

19. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to



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be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

20. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

21. **Claims 1-14** are rejected under 35 U.S.C. 103(a) as being unpatentable over Kodimer in view of Microsoft Computer Dictionary in further view of Official Notice.

Kodimer discloses all of the limitations as laid out above. Further still Kodimer claims nearly the identical invention as Applicant in that it detects the condition of a network peripheral device and notifies a sales promoting terminal; thus allow a sales person to confirm through the sales terminal the service status of a computer peripheral without taking trouble of visiting customers. Moreover Kodimer teaches being able to detect "exceeding a threshold quantity of usage" (C12, 50-65 and claim 3).

In fact the only thing Kodimer fails to teach is that the network peripheral device is *only* a data storing apparatus. And the status/quantity of usage determination is that "of a spent disk capacity and load status of said data storing apparatus".

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The Examiner however directs attention to the Microsoft Computer Dictionary definition of "peripheral" page 360 that establishes the equivalency of printer and disk drive/data storage device in the computing art as known peripherals. *As noted in the Dictionary both printer and storage devices are standard peripherals used in conjunction with a computer.* The substitution of a storage device for the printer of Kodimer would have been obvious to one of ordinary skill in the art at the time of the invention as it is irrelevant whether a the computer peripheral is a printer or storage device so long as the status of the peripheral is detected and sent to a "sales promoting terminal" as each is a standard peripheral used by the ordinary artisan and both have been recognized in the art as such.

As to the actual "status" being detected and sent to the sales promoting terminal; the Examiner takes Official Notice that in the COMPUTER ART included within the bounds of checking the status of a storage device is that of checking the spent disk capacity and load status of said data storing apparatus as a convenient way for a user to determine available load capacity and future storage needs. It would have been obvious to one having ordinary skill in the art at the time of the invention to have checked for load status in the Kodimer reference if the peripheral was a storage apparatus as noted by Microsoft because the skilled artisan would have recognized that checking available/remaining disk space is key in checking the "status" of a storage device and that to automate this practice would save a consumer time of physically having to check disk storage and notify a sales terminal of the deficiency of load.

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NOTE: Applicant's own submitted IDS substantiate Examiner's Official Notice that if one were checking status of a storage apparatus peripheral, that checking load is the way to go.

***Response to Arguments***

22. Applicant's arguments filed 7/20/07 and 8/22/07 have been fully considered but they are now moot or not persuasive.

23. First in reply to 7/20/07

24. With respect to the drawings it is again requested that the system components be properly shown in drawing or the features cancelled from the claims. Examiner almost laughs at the newly submitted drawing fig 7. (see above)

25. As to the consecutive argument Examiner maintains the argument presented in final office action dated 9/14/06.

26. As to Kodimer not teaching a manufacturing point terminal, this is not true. Kodimer teaches a manufacturing point terminal to the same degree that applicants specification discloses (see above).

27. Further as to the bottom of page 8, applicant states mfg terminal manages supply information then in the next line states that the sales terminal mediates the supply information. What is the difference between managing and mediating and please show exactly where in the specification this is described and or taught.

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28. In reply to remarks 8/22/07; Applicant states that support for the new claim language is found on page 19, lines 3-17. First off Examiner has done preliminary search of spec and cannot find terms "mediate supply" and or "manage supply" in the submitted text for support. Further and more annoyingly applicant said that the spec teaches/describes "manufacturing point terminals 71-73 reference a database of products and retail stores to confirm the existence/nonexistence of products desired to be purchased at a retail store" yet when Examiner looks to the quoted text, it is simply not there. At best applicant did not even accurately repeat own specification! The specification is all jumbled and confusing such as discussed above.

#### ***Conclusion***

29. A shortened statutory period for reply to this action is set to expire THREE MONTHS from the mailing date of this action.

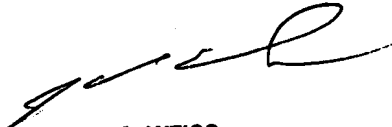
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew L. Brooks whose telephone number is (571) 272-8112. The examiner can normally be reached on Monday - Friday; 8 AM - 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-8112. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MLB  
10/29/2007



JOHN G. WEISS  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600